

## **REMARKS**

Claims 1-10 are the claims currently pending in the Application.

Claims 1-4 are amended to clarify features recited thereby.

### ***Formal Matters***

Applicant respectfully requests that the Examiner acknowledge the claim for foreign priority and the receipt of the priority document.

Applicant thanks the Examiner for acknowledging review and consideration of the references cited in the Information Disclosure Statement filed on July 5, 2001.

The Examiner is respectfully requested to acknowledge review and consideration of the references cited in the Information Disclosure Statement filed on October 13, 2004.

### ***Rejection of claims 1-5 and 7-10 under 35 U.S.C. § 102***

Claims 1-5 and 7-10 are rejected under 35 U.S.C. § 102(b) as being anticipated by Nishino, et al. U.S. Patent No. 5,295,068. This rejection is traversed.

Among the problems recognized and solved by Applicant's claimed invention is that a user who receives an electronic mail in a foreign language, or wishes to send e-mail to a recipient in a foreign language, first needs to order a translation, such

as a machine translation.<sup>1</sup> According to an aspect of Applicant's claimed invention, an electronic service provider or the like automatically submits for translation an e-mail when the transmitting party is a pre-specified user or the e-mail is addressed to a pre-specified user.

Applicant's claimed invention is neither anticipated by nor obvious from the cited prior art. By way of example, independent claims 1 and 3 require judging whether translation is required based on at least one of sender data associated with the electronic mail and addressee data associated with the electronic mail.

Nishino discloses registering private-use words in a machine translation electronic mail system (Nishino, Abstract), such that words that do not appear in the standard dictionary of the machine translation system, such as a newly created words or words that have a special meaning for the user, are stored in a private-use words dictionary (Nishino, column 1, lines 49- 62; Figure 1, Reference Numerals 9 and 10).

Nishino does not disclose or suggest judging whether translation of an electronic mail is required. Further, Nishino does not disclose or suggest performing such judging based on at least one of sender data associated with the electronic mail and addressee data associated with the electronic mail. Therefore, Nishino does not disclose or suggest the recitations of independent claims 1 and 3.

In fact, Nishino belongs to the prior art recognized by Applicant's claimed invention because Nishino does not address the problem recognized and solved by

---

<sup>1</sup> This discussion merely illustrates aspects of Applicant's claimed invention. Applicant does not represent that every embodiment of Applicant's claimed invention necessarily embodies or performs the solutions herein discussed.

Applicant's claimed invention, as for example discussed above, let alone disclose or suggest the solutions provided by Applicant's claimed invention.

Claims 2-5 and 7-10 incorporate novel and nonobvious features of independent claims 1 and 3, and accordingly, claims 2-5 and 7-10 are patentably distinguishable over the prior art for at least the reasons that their base claims are patentably distinguishable over the prior art. Accordingly, this rejection should now be withdrawn.

***Rejection of claim 6 under 35 U.S.C. § 103***

Claim 6 is rejected under 35 U.S.C. § 103 as being obvious from Nishino. This rejection is traversed.

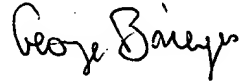
Claim 6 depends from independent claim 3, and thus incorporates novel and nonobvious features thereof. Therefore, claim 6 is patentably distinguishable over the prior art for at least the reasons that independent claim 3 is patentably distinguishable over the prior art. Accordingly, this rejection should now be withdrawn.

For at least the reasons set forth in the foregoing discussion, Applicant believes that the Application is now allowable, and respectfully requests that the Examiner reconsider the rejections and allow the Application. Should the Examiner have

any questions regarding this Amendment, or regarding the Application generally, the

Examiner is invited to telephone the undersigned attorney.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "George Brieger".

George Brieger  
Registration No. 52,652

Scully, Scott, Murphy & Presser  
400 Garden City Plaza  
Garden City, New York 11530  
(516) 742-4343, Ext. 503

GB:eg